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EXAMINER
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WASSUM, LUKE S

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BEFORE THE BOARD OF PATENT APPEALS  
AND INTERFERENCES

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*Ex parte* VINCENTIUS PAULUS BUIL and  
JOSEPHUS HUBERTUS EGGEN

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Appeal 2008-1992  
Application 09/932,070  
Technology Center 2100

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Decided:<sup>1</sup> April 10, 2009

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Before JAMES D. THOMAS, JOSEPH L. DIXON, and  
STEPHEN C. SIU, *Administrative Patent Judges*.

THOMAS, *Administrative Patent Judge*.

DECISION ON APPEAL

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<sup>1</sup> The two-month time period for filing an appeal or commencing a civil action, as recited in 37 C.F.R. § 1.304, begins to run from the decided date shown on this page of the decision. The time period does not run from the Mail Date (paper delivery) or Notification Date (electronic delivery).

### STATEMENT OF THE CASE

This is an appeal under 35 U.S.C. § 134(a) from the Examiner's final rejection of claims 1 through 9, 11 through 15, and 17 through 21, Appellants having cancelled claim 16 and the Examiner having objected to claim 10 as noted at pages 2 and 3 of the Answer. We have jurisdiction under 35 U.S.C. § 6(b).

We affirm.

#### *Invention*

The invention relates to a system for browsing a collection of information units, such as audio or video files, comprising presentation means for presenting an information unit from said collection, and attribute means for associating a respective information unit with an attribute value for at least a first attribute. The system randomly selects information units which meet certain criteria for said first attribute. The selection and presentation is made without interaction by a user. (Spec. 11, Abstract; claim 1).

#### *Representative Claim*

1. A system for browsing a collection of information units, comprising presentation means for presenting at least one of said information units via audio or video playback, and attribute means for associating a respective one of said information units with an attribute value for a plurality of attributes, wherein the system comprises random selection means for automatically randomly selecting and presenting for playback a unit whose attribute value meets a criterion,

the selection and presentation for playback being made without interaction by a user based on the plurality of attributes.

*Prior Art and Examiner's Rejections*

The Examiner relies on the following references as evidence of anticipation and unpatentability:

Cluts	5,616,876	Apr. 1, 1997
Dunning	2003/0229537 A1	Dec. 11, 2003 (filed Apr. 30, 2001)

Dependent claims 18 and 20 stand rejected under 35 U.S.C. § 112, first paragraph, the written description portion. Claims 1 through 5, 9, 11 through 15, and 21 stand rejected under 35 U.S.C. § 102(b) as being anticipated by Cluts. Lastly, claims 6 through 8, and 17 through 20 stand rejected under 35 U.S.C. § 103(a). As evidence of obviousness, the Examiner relies upon Cluts in view of Dunning.

*Claim Groupings*

Based upon Appellants' arguments in the principal Brief, Appellants consider the corresponding features of claims 18 and 20 collectively with respect to the rejection under the first paragraph of Section 112. They also consider the subject matter of independent claims 1, 11, and 21 collectively, and independent claim 14 is argued separately with respect to the rejection under Section 102. Separate arguments are presented as to dependent claims 2, 3, 12, and 15 within this rejection under 35 U.S.C. § 102. With respect to the rejection of certain claims under 35 U.S.C. § 103, claims 6 and 17 are

considered representative of claims 6 through 8 and 17 through 20 respectively.

### ISSUES

1. Have Appellants shown that the Examiner erred in finding that the subject matter of dependent claims 18 and 20 has no written description support within 35 U.S.C. § 112, first paragraph?

2. Have Appellants shown that the Examiner erred in finding that Cluts anticipates the subject matter of the noted claims as grouped earlier in this opinion?

3. Have Appellants shown that the Examiner erred in finding that the subject matter of representative claims 6 and 17 would have been obvious to the artisan within 35 U.S.C. § 103?

### *Prior Decision*

This application was subject to a prior Decision by an earlier panel of the Board noted as Appeal No. 2006-0531, decided on February 28, 2006. Since the Examiner has utilized two of the same references in this present appeal as were utilized in the prior appeal, we reproduce here our findings with respect to Cluts as reflected in our discussion at pages 3 and 4 of our prior Decision:

At least with respect to those portions of Cluts specifically relied upon by the examiner (column 4, lines 38 through 54; column 14, lines 28 through 50 and column 18, lines 51 through 54), Cluts effectively in our view teaches the substance of the subject matter of representative independent claim 1 on appeal. In Cluts, at least with

respect to the style tables and the ability to utilize a so-called style slider, there exists an association as claimed of an individual song or information unit with a criterion such as a given style of music. Additionally, at least one seed song entered by a user may correspond to the claimed criterion which is met by the structure and software in a comparison operation which functions in an automatic random selection and presentation process to present the new selections of songs to the user.

Contrary to the apparent view expressed by the examiner at the bottom of page 4 of the answer, it appears to us from our study of this reference that Cluts does automatically select and present a new song without interaction by a user. It is emphasized here that the requirement of claim 1 is that this automatic selection and automatic presentation be done without an interaction by the user, thus indicating in the claim that the user may specify a given criterion. Even appellants disclose an invention and in an example require a user to enter into the overall system as disclosed a criterion on which the system is to automatically and randomly select a given new song for presentation. The ability of the user in Cluts to select a so-called seed song or initial criterion as well as to set a style slider mechanism to a given position permits the user in Cluts to establish a relative association of a given style to individual songs. The user also has the ability to select the "more style" button and the "more" and "like" buttons as depicted in Figures 5 through 10. In any event, the flow chart element 1020 in Figure 10 clearly corresponds to the teaching relied upon by the examiner at column 18, lines 51 through 54 that the system automatically does a random sort of a list of songs before presentation to a listener.

Also with respect to Cluts, we noted in the paragraph bridging pages 7 and 8 of the prior Decision that the subject matter of program product client 13 was met by the teachings at column 22, line 51 to the end of the patent of Cluts. Although the Examiner does not utilize in this appeal the reference to

Looney<sup>2</sup>, this reference was stated as having corresponding analogous teachings as in Cluts at page 5 of the prior Decision. Lastly, we stated in the paragraph bridging pages 6 and 7 of our prior Decision that “[e]ven at the bottom of page 16 of the brief, in characterizing the examiner’s view that it was well known in the art to randomize the function of CD players, appellants have not denied this assertion made by the examiner on its merits.”

### FINDINGS OF FACT

1. As quoted at pages 2 and 3 of the Reply Brief, the Discussion of the Summary of the Invention, at page 3, lines 1 through 24 of the Specification, discusses a user-operable skip means and an ability to abort the presentation of the currently selected information unit. The discussion at lines 10 through 24 relates to the number of times or the frequency in which a skip button would be utilized as well as the length of time or duration in which this button would be pressed. With respect to the Figure 3 embodiment, the discussion at page 7, line 32 through page 8, line 16 of the Specification is more explicit by giving various examples of the number of times and the duration in which a button 303 of the Figure 3 embodiment is pressed.

2. The Specification at page 5, line 6 through 9, states: “[r]andom selection means 103 [of Figure 1] are capable of randomly selecting a music file from the database 101 and sending it to an audio processor 104 and a loudspeaker 105, which thus constitute presentation means for presenting the

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<sup>2</sup> Looney, U.S. Patent 5,969,283.

audio file.” With respect to the same Figure, the paragraph at lines 15 through 21, relates to a personal computer embodiment and the retrieval of music files from a database of the personal computer “and presenting them via the computer’s sound card and loudspeakers” as noted at lines 20 and 21.

3. It is not disputed that the patent of Cluts relates to downloading audio or video files as claimed. In an initial screen display, shown in Figure 4, a find button 420 permits the user to find a specific song within the database of Cluts. Alternatively, the list function keys 425 permit the user to retrieve user selected, predetermined playlists by the actuation of these buttons. With respect to the showings in Figures 5 and 6, we note the discussion at column 13, lines 38 through 40, which state that “a playlist is a collection of songs. When a playlist is selected, the audio on demand system begins to play the first song in the playlist.” The discussion beginning at column 13, line 63, relating to Figure 5, makes a specific mention of the so-called “more” button 540 which activates the “more like” music search function, the details of which are extensively discussed through the top of column 17. This includes a discussion of Figures 7 and 8 relating to the actuation of “more style” button 720 within the “more like” panel 705 as well as the illustration of the capability of actuating functions relating to the “more artists” respective button 705 and the “more album” with respect to button 710. A so-called “style slider” button 725 is also illustrated.

4. With respect to the flow chart Figure 9, we reproduce the following from column 17, lines 4 through 12:

FIG. 9 is a flow diagram that summarizes the steps carried out by a subscriber who is using the more button 540 to find more music. The method 900 begins at step 905 when the user selects a song to hear. This is accomplished by using the find button to select a



specific song, or by selecting a playlist. Those skilled in the art will appreciate that the "more like" function uses the current song as a "seed song" 10 and selects other songs that match the style criteria associated with the seed song.

5. A brief mention is made of Figure 10 at column 17, lines 23 through 31, the details of which are discussed beginning at line 50. We reproduce here the text of lines 50 through 55:

FIG. 10 is a flow diagram illustrating the "more like" function of the present invention as implemented in a program module running on a headend server, which forms a part of the interactive network. The method 1000 begins at step 1005 after the user has selected a seed song and activated the more style button.

The details of flow chart Figure 10 continue to be discussed through column 19. The entire discussion of Figure 10 relates to the system performing automatically and without user interaction the functions of determining the position of a style slider noted earlier, the functions of identifying songs with a similar style as a seed song entered by the user and the functions of randomly sorting this list of newly found songs and finally automatically presenting to the user the top ten songs thus obtained. Additionally, a corresponding automatic, without user interaction, capability is illustrated in Figure 13 of the style equalizer feature 510 in Figure 5 of Cluts.

6. With respect to the hold function set forth in dependent claims 2 and 12 and in independent claim 14, we note the discussion of Figures 7 and 8 beginning at column 16, line 25 and the corresponding showing in Figure 10 in block 1045.

7. With respect to dependent claim 3, we note that the discussion of the “more like” function beginning at column 14, line 12, where it is specifically stated at lines 41 and 42 that “[e]ach song can be associated with any number of different styles.” Associated with this discussion is an extensive discussion of searching, matching, and weighting according to Cluts’ subjective similarity of song approach.

8. With respect to dependent claims 6 and 17, Cluts already teaches features of aborting and skipping with respect to the discussion at column 11, lines 43 through 46; the showing in Figure 5 and the corresponding discussion at column 13, line 44 through column 14, line 11; the separate showings in Figures 7 and 8 and the corresponding discussion at column 16, lines 34 through 37, and lines 50 through 53; the showing in Figure 9 in elements 930, 940, and 945, and the separate illustration in Figure 10 with respect to elements 1030, 1040, and 1045.

9. In the paragraph bridging pages 15 and 16, Dunning’s paragraph [0256] is reproduced here:

Finally, play logs may include information as to which tracks were repeated, which were aborted or skipped, and at what volume level the tracks were played. Weights can be assigned to tracks in the log, based on such observations. For example, the system may assign a higher weight to a track that was repeated on the assumption that the user probably enjoyed that track, while a lower weight may be assigned to a track that was skipped halfway through, on the assumption that the user probably did not enjoy the track.

## PRINCIPLES OF LAW

### *Anticipation*

“A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference.” *Verdegaal Bros. v. Union Oil Co. of California*, 814 F.2d 628, 631 (Fed. Cir. 1987). Analysis of whether a claim is patentable over the prior art under 35 U.S.C. § 102 begins with a determination of the scope of the claim. We determine the scope of the claims in patent applications not solely on the basis of the claim language, but upon giving claims their broadest reasonable construction in light of the specification as it would be interpreted by one of ordinary skill in the art. *In re Am. Acad. of Sci. Tech. Ctr.*, 367 F.3d 1359, 1364 (Fed. Cir. 2004). The properly interpreted claim must then be compared with the prior art.

### *Obviousness*

"[T]he PTO gives claims their 'broadest reasonable interpretation.'" *In re Bigio*, 381 F.3d 1320, 1324 (Fed. Cir. 2004) (quoting *In re Hyatt*, 211 F.3d 1367, 1372 (Fed. Cir. 2000)). "Moreover, limitations are not to be read into the claims from the specification." *In re Van Geuns*, 988 F.2d 1181, 1184 (Fed. Cir. 1993) (citing *In re Zletz*, 893 F.2d 319, 321 (Fed. Cir. 1989)). Our reviewing court has repeatedly warned against confining the claims to specific embodiments described in the specification. *Phillips v. AWH Corp.*, 415 F.3d 1303, 1323 (Fed. Cir. 2005) (en banc).

One cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references. *In re Merck & Co., Inc.*, 800 F.2d 1091, 1097 (Fed. Cir. 1986).

Section 103 forbids issuance of a patent when “the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains.”

*KSR Int’l Co. v. Teleflex Inc.*, 127 S. Ct. 1727, 1734 (2007).

The Supreme Court emphasized “the need for caution in granting a patent based on the combination of elements found in the prior art,” and discussed circumstances in which a patent might be determined to be obvious. *Id.* at 1739 (citing *Graham v. John Deere Co.*, 383 U.S. 1, 12 (1966)). The Court reaffirmed principles based on its precedent that “[t]he combination of familiar elements according to known methods is likely to be obvious when it does no more than yield predictable results.” *Id.* The operative question in this “functional approach” is thus “whether the improvement is more than the predictable use of prior art elements according to their established functions.” *Id.* at 1740.

We must determine whether or not the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. *See id.* at 1734. Obviousness determination is not the result of a rigid formula, and we will consider the facts of a case and the common sense of those skilled in the art. *Leapfrog Enters., Inc. v. Fisher-Price, Inc.*, 485 F.3d 1157, 1161 (Fed. Cir. 2007). That is, the test for obviousness is

rather what the combined teachings of the references would have suggested to those of ordinary skill in the art. *See In re Keller*, 642 F.2d 413, 425 (CCPA 1981); *In re Young*, 927 F.2d 588, 591 (Fed. Cir. 1991).

### ANALYSIS

Because we generally agree with Appellants' arguments at pages 2 through 4 of the Reply Brief, the rejection of dependent claims 18 and 20 under the written description portion of the first paragraph of 35 U.S.C. § 112 is reversed (Issue 1). The material we noted earlier in Finding of Fact 1 justifies the features recited in these claims with respect to a mode of operation of the skip means being selected from "the group consisting of frequency of skip means operation and duration of skip means operation." Although not expressed in this noted portion of the Specification in corresponding terms, the number of times the pressing and the duration of the pressing of the skip button discussed in the portions in Finding of Fact 1 of the Specification as filed, clearly convey to the artisan the notion of frequency of operation of the skip button as well as the duration of time of operation of the skip button. Contrary to the apparent view of the Examiner, there is no word for word or "*ipsis verbis*" requirement for the written description portion of 35 U.S.C. § 112, first paragraph. This is discussed in detail in MPEP § 2163.01.

We turn now to Issue 2 and begin with the rejection of representative independent claim 1 on appeal as representative of the subject matter of claims 1, 11, and 21. The only part of the Examiner's extensive discussion in the responsive arguments portion in the Answer that relates to certain identifiable features of claim 1 is identified in the paragraph bridging pages

5 and 6 of the Reply Brief. The reader should first understand the material we quoted from our prior Decision earlier in this appeal relating to the automatic and random features associated with Figure 10 as to the disputed feature of the selection and presentation for playback being made without interaction by a user. Our discussion of this is also noted in Finding of Fact 5 in this Opinion.

On the other hand, the bulk of the discussion in the Reply Brief focuses on the feature of the “presentation means for presenting . . . information units via audio or video playback” and the additional recitation at the end of claim 1 of “the selection and presentation for playback being made without interaction by a user.”

Finding of Fact 2 and the showing in Figure 1 of the Specification as filed clearly conveys to the reader the concept of the presentation means presenting at least one of the information units “via” audio or video playback as conveying to the reader, as argued at page 6 of the Reply Brief, that the claim requires an initial actual playback operation for at least one of the information units or music selections. At least with respect to the recitation of this portion of claim 1, the claim is construed to require an actual audio playback operation because of the specific references to the audio processor 104 and loudspeaker 105 in Figure 1 are stated to constitute the presentation means for presenting the audio file. The features of “sending” in independent claim 14 as well as a corresponding sending function in independent claim 21 are also encompassed by this teaching in Finding of Fact 2. The use of the claimed word “via” also noted in Finding of Fact 2, relating to the computer’s sound card and loud speakers. We therefore agree with what appears to be Appellants’ first argument at page 6

of the Reply Brief that there is a recited function at least with respect to the so-called “via” clause of claim 1.

On the other hand, we do not necessarily agree with the Appellants’ view that the recitations at the end of claim 1 of selecting and presenting “for playback” relate to a statement of playing back since plainly, “for playback” is not recited as occurring in the present tense and is clearly different than “playing back” in the present tense.

Thus, an initial presentation requires an information unit or music selection to be played, yet the remaining portions of the claim do not positively require a playback function but merely a presenting for the user a playback selection upon which a separate function or act of the user must be necessary for the actual playback event to occur. Additionally, even if we were to construe the selection and presentation “for playback” as constituting a positive statement of playing back, our finding of anticipation by Cluts still applies.

These claim interpretation issues consider the subject matter of independent claim 1 most favorable to Appellants. The same may be said of the sending function in independent claim 14 and the ability of sending to a presentation means for playing in that claim. The same sending function is recited as “sending the selected unit for playback by a playback device” in independent claim 21.

In addition to our initial findings in our prior Decision noted earlier in this appeal, Findings of Fact 3 through 5 clearly convey to the artisan the understanding from the various embodiments of Cluts that Cluts’ system requires at least the playing (and thus a sending) of an initial selection of a song, which may be characterized as a so-called “seed song.” The user’s

manual operation (Finding of Fact 4) in Figure 9 is contrasted by Cluts' embodiment in Figure 10. As depicted in Figure 10 and briefly discussed in Finding of Fact 5, selection and presentation then automatically and without user interaction provides for further presentation to the user of more songs from the database that have a similar "style." Block 1020 performs a random sort of the newly derived songs from the automatic system of operation in Figure 10 just before the presentation of them in the form of 10 songs in block 1025, from which the user must selectively determine which songs are accepted or not in decision block 1030. There is no requirement of an automatic random selection and presentation in independent claim 14, merely the random selection occurring. It is not until dependent claim 15 that recites the function of random selection must occur without the user's interaction. With respect to independent claim 11, there is a comparable recitation of automatically and randomly selecting and presenting substantially like the feature in independent claim 1. (Claim 11 reproduced as an attachment to the principal Brief on appeal does not reflect the amendments entered on April 28, 2006 and presented again in the amendment of October 17, 2006.)

We generally agree with the Examiner's correlation of features of Cluts to the subject matter of argued dependent claims 2, 3, 12, and 15. Findings of Fact 6 and 7 provide additional support for the Examiner's findings. The Reply Brief does not contest or otherwise traverse the Examiner's findings with respect to these claims. Thus, the weight and extent of the arguments and evidence support the Examiner's findings with respect to these claims.



We turn now to the rejection under 35 U.S.C. § 103 of representative dependent claims 6 and 17 (Issue 3) where the Examiner relies upon Cluts in view of Dunning. As to the combinability argument, the requirements of combinability with respect to the case law noted in this Opinion are buttressed by the findings we made in Finding of Fact 8 with respect to the teachings already present in Cluts relating to the argued features of aborting and otherwise skipping the selection of a song. The discussion in Finding of Fact 9, noted by the Examiner in the discussion bridging pages 39 and 40 of the Answer, buttresses the already extensive teachings of aborting and skipping noted earlier that are already present in Cluts. The arguments at pages 16 and 17 of the principal Brief on appeal do not appear in fact to contest the Examiner's reliance upon specific features of Dunning and only on their face allege the lack of proper combinability within 35 U.S.C. § 103. In view of our discussion noted here, the position at the top of page 17 of the principal Brief that "it would make little or no sense to apply Dunning's playback skip function to Cluts' tabular list of songs as suggested by the Examiner" is clearly misplaced.

### CONCLUSIONS OF LAW

1. Appellants have shown that the Examiner erred in finding that the features recited in dependent claims 18 and 20 have no written description basis within the present invention's disclosure as required by the written description portion of 35 U.S.C. § 112, first paragraph.
2. Appellants have not shown that the Examiner erred in finding that the subject matter of the noted representative claims were anticipated by Cluts.

3. Likewise, Appellants have not shown that the Examiner erred in finding that the combination of teachings of Cluts and Dunning would have rendered obvious the subject matter of representative dependent claims 6 and 17 on appeal.

### DECISION

The Examiner's rejection of dependent claims 18 and 20 under the written description portion of the first paragraph of 35 U.S.C. § 112 is reversed. The rejection of various claims under 35 U.S.C. § 102(b) is affirmed, as is the separate rejection of further dependent claims under 35 U.S.C. § 103. Since at least one rejection of every claim on appeal is affirmed, the decision of the Examiner is affirmed. Claims 1 through 9, 11 through 15, and 17 through 21 are not patentable.

No time period for taking any subsequent action in connection with this appeal may be extended under 37 C.F.R. § 1.136(a)(1)(iv).

### AFFIRMED

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